

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Au et al.**

Serial No. **09/859,705**

Filed: **May 17, 2001**

For: **Method and Apparatus For a
Distributed Web Commerce System**

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Group Art Unit: **3714**

Examiner: **Ronald Laneau**

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

35526
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

REPLACEMENT APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Reinstatement of the Notice of Appeal, filed in this case on August 18, 2006.

No fee is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 50-0510. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 50-0510. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 50-0510.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-15, and 32-46.

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 16-31 and 47-73.
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 1-15, and 32-46.
4. Claims allowed: None.
5. Claims rejected: 1-15, and 32-46.
6. Claims objected to: None.

C. CLAIMS ON APPEAL

The claims on appeal are: 1-15, and 32-46.

STATUS OF AMENDMENTS

No amendments were submitted after the office action of May 18, 2006.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 1 - INDEPENDENT

The subject matter of claim 1 is directed to a method in a primary data processing system for managing a catalog (Specification, p. 4, ll. 5-21; and Figure 5, reference numerals 504 and 506).

The method includes sending a catalog and user information to a plurality of secondary data processing systems located in a network data processing system (Specification, p.12, ll. 6-21; and Figure 5, reference numerals 504 and 506), allocating inventory associated with the catalog to the plurality of secondary data processing (Specification, p.12, ll. 6-21; and Figure 5, reference numerals 504 and 506), receiving an order from one of the plurality of secondary data processing systems (Specification, p.12, ll. 6-21; and Figure 5, reference numerals 508, 510, 502, 504 and 506), and processing the order, in response to receiving the order (Specification, p. 13, ll. 3-14; and Figure 14).

B. CLAIM 32 - INDEPENDENT

The subject matter of claim 32 is directed to a data processing system for managing a catalog (Specification, p. 4, ll. 5-21; and Figure 5, reference numerals 504 and 506). The data processing system includes a sending means (Figure 5, reference numerals 510, 508) for sending a catalog and user information to a plurality of secondary data processing systems located in a network data processing system (Specification, p.12, ll. 6-21; and Figure 5, reference numerals 504 and 506), an allocating means (Figure 5, reference numerals 502, 504, and 506) for allocating inventory associated with the catalog to the plurality of secondary data processing systems (Specification, p.12, ll. 6-21; and Figure 5, reference numerals 504 and 506), a receiving means (Figure 5, reference numerals 502, 504, 506) for receiving an order from one of the plurality of secondary data processing systems, and processing means (Figure 5, reference numerals 504, 506) for processing the order, in response to receiving the order (Specification, p.12, ll. 6-21; Specification, p. 13, ll. 3-14; Figure 14; and Figure 5, reference numerals 508, 510, 502, 504 and 506).

C. CLAIM 37 - DEPENDENT

The subject matter of claim 37 is directed to the data processing system of claim 32 which further includes an obtaining means (Figure 5, reference numerals 502, 504, 506) for periodically obtaining necessary shopping cart data from at least one secondary data processing system within the plurality of secondary data processing systems to primary data processing system (Specification, p. 20, ll. 3-17; and Figure 14), and a forwarding means (Figure 5, reference numerals 502, 504, 506) for forwarding the necessary shopping cart data to other secondary data processing systems within the plurality of secondary data processing systems (Specification, p. 20, ll. 3-17; and Figure 14).

D. CLAIM 41 - DEPENDENT

The subject matter of claim 41 is directed to the data processing system of claim 32, wherein the sending means is a first sending means and is further comprised of a detecting means (Figure 5, reference numeral 502) for detecting a presence of another secondary data processing system (Specification, p.12, ll. 6-21; and Figure 5, reference numeral 502), and a fourth sending means (Figure 5, reference numerals 502, 504, 506) for sending the catalog to the another secondary data processing system in response to detecting the presence (Specification, p.14, l. 24 through p. 15, l. 19; and Figure 5, reference numerals 502, 504, and 506).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. GROUND OF REJECTION 1 (Claims 1-8, 11-15, 32-39, and 42-46)

Whether the examiner failed to state a *prima facie* obviousness rejection against claims 1-8, 11-15, 32-39, and 42-46 under 35 U.S.C. §103 as obvious over *Westrope et al.*, Method and Apparatus for an Interactive On Line Catalog System for Facilitating International, Cross-Border Transactions, U.S. Patent 5,968,110 (October 19, 1999) (hereinafter “*Westrope*”) in view of *Kennedy et al.*, System and Method for Allocating Manufactured Products To Sellers, U.S. Patent 6,167,380 (December 26, 2000) (hereinafter “*Kennedy*”).

B. GROUND OF REJECTION 1 (Claims 9, 10, 40, and 41)

Whether the examiner failed to state a *prima facie* obviousness rejection against claims 9, 10, 40, and 41 under 35 U.S.C. §103(a) as obvious over *Westrope* in view of *Yamazoe et al.*, System of and Method for Exchanging Information on Commercial Transaction Exploiting Electronic Catalog and System of and Method for Collecting and Storing Marketing Information, U.S. Patent Application Publication 2001/0032148 (October 18, 2001) (hereinafter “*Yamazoe*”).

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1-8, 11-15, 32-39, and 42-46)

The examiner rejects claims 1-8, 11-15, 32-39, and 42-46 as obvious over *Westrope* (U.S. Patent 5,968,110) in view of *Kennedy* (U.S. Patent 6,167,380). Applicants show that this rejection is in error in three parts, (1) with respect to claims 1-3, 8, 11-15, 32-34, 39, and 42-46; (2) with respect to claims 4, 5, 35, and 36; and (3) with respect to claims 6, 7, 37, and 38.

A.1. Claims 1-3, 8, 11-15, 32-34, 39, and 42-46

Claim 1 is a representative claim in this grouping of claims. Claim 1 is as follows:

1. A method in a primary data processing system for managing a catalog, the method comprising:
 - sending a catalog and user information to a plurality of secondary data processing systems located in a network data processing system;
 - allocating inventory associated with the catalog to the plurality of secondary data processing systems;
 - receiving an order from one of the plurality of secondary data processing systems; and
 - processing the order, in response to receiving the order.

Regarding the rejection of claim 1, the examiner states that:

As per claims 1, 3, 8, 11-15, 32-35 and 42-46, *Westrope et al* teach a method in a primary data processing system for managing a catalog (fig. 5, catalog data processor 67), method comprising: sending a catalog and user information to a plurality of secondary data processing system located in a network data processing system (marketing data processor 75, accounting processor 73); receiving an order from one of the plurality of secondary data processing systems and processing the order, in response to receiving the order (fig. 5, 43). *Westrope* does not explicitly disclose allocating the inventory but *Kennedy* discloses for allocating products to sellers, for managing available to promise (ATP) and making promises to fulfill customer requests

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the allocation of products as taught by *Kennedy* into the data processing as taught by *Westrope* because it would provide an automatic allocation policy that allows the organization to designate a forecast entry such that the available-to-promise (ATP) product is always zero (col. 3, lines 18-21).

As per claim 2, *Westrope* discloses a system that sends an update to the catalog to the plurality of secondary data processing systems as claimed (col. 9, line 66 to col. 10, line 3).

Office Action of May 18, 2006, pp. 2-3.

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). For an invention to be *prima facie* obvious, the prior art must teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the case at hand, the cited references when considered as a whole do not teach or suggest all of the limitations of the claims, arranged as they are in the claims.

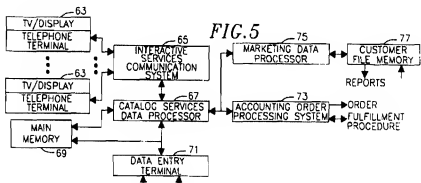
In particular, the proposed combination of *Westrope* and *Kennedy*, when considered together as a whole, does not teach or suggest the claimed feature of, “sending a *catalog and user information* to a plurality of *secondary data processing systems* located in a network data processing system,” as recited in claim 1. Contrary to the examiner’s assertions, *Westrope* does not teach or suggest this claimed feature. *Kennedy* is devoid of disclosure in this regard. For this reason, the proposed combination does not teach all of the features of claim 1. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1. Applicants prove that the examiner is mistaken below.

A.1.i. *Westrope* and *Kennedy* Combined Do Not Teach Sending a Catalog and User Information To a Plurality of Secondary Data Processing Systems

Regarding the claimed step of sending a catalog and user information to a plurality of secondary data processing systems, the examiner states that marketing processor 75 and accounting processor 73 are a plurality of secondary data processing systems used in the claimed manner. However, the examiner is manifestly incorrect, as has been pointed out to the examiner in prior office action responses and in the prior request for pre-appeal brief.

In support of this assertion the examiner has stated that, “...*Westrope* in fact disclose a

plurality of secondary data (marketing data processor 75, accounting data processor 73) seen in fig. 5.” Office action of April 21, 2005. In the office action of September 28, 2005, the examiner stated, “Contrary to Applicant’s arguments, the catalog services data processor (fig. 5, 67) is coupled to the secondary data processing systems (marketing data processor and accounting data processor) so that the catalog and user information can be sent or transmitted to the secondary data processing systems.” The examiner did not address this issue in the current office action. However, the examiner’s characterization of *Westrope* continues to be clearly incorrect based on the plain meaning of *Westrope*. For example, figure 5 of *Westrope* is as follows:



The text related to figure 5 states, in relevant part:

The electronic catalog data would be entered via data terminal 71 and stored in selectable memory locations in the main memory 69. Preferably applicants' system would include electronic catalog data for a plurality of different catalogs from different companies.

...

If a user elects to order a specific product or service, this is done under menu control at a user terminal and the menu would prompt the user to enter the appropriate order data codes via, for example, a touchtone telephone pad on the user terminal 63. In response to receipt of such user order data codes, the catalog data processing signals the accounting and order processor 73, which is similar in function and structure to the order and accounting processor of FIGS. 1 and 3 to exercise the appropriate order processing requests to clear the customer/user's financial payment authorization and initiate the order fulfillment procedure to have the ordered products assembled and mailed to the address directed by the user/customer for that particular transaction. As herein above described in conjunction with FIGS. 1 and 3, the catalog data processor 67 in response to a customer/user order signals the marketing data processor 75, which is similar in structure and function to the marketing data processor described above in connection with FIGS. 1 and 4, to generate, unless the customer does not so authorize, customer profile marketing data in file 77 as described in FIGS. 6, 7 and 8. Accounting and order processor 73, which is

structurally and functionally equivalent to the accounting and order processor described in FIGS. 1 and 3, initiates various accounting, financial payment authorization and/or assembly and shipping procedures as described in conjunction with FIGS. 6, 7 and 8. Accounting and order processor 73 as illustrated in FIG. 8 also in response to a command from the central data processor 67 initiates a software or program routine procedure to generate commission data for accumulating a commission file entry for the individual host hotel or site of the interactive catalog subsystem from which a particular order originated.

Westrope, col. 6, l. 58 through col. 7, l. 65. (Emphasis in italics and underline to show portions relevant to the present case; emphasis in bold to show portions cited by the examiner.)

Figure 5 and the accompanying text in *Westrope* do not teach sending a catalog and user information to a plurality of secondary data processing systems, as recited in claim 1. Even if the accounting order processing processor (73) and the marketing data processor (75) could be construed as a plurality of secondary data processing systems as claimed, which as shown below they are not, *Westrope* does not show sending a catalog and user information to either system. Regarding the former system, *Westrope* sends only a signal to the accounting order processing processor 73 to process the customer financial data and customer ordering data. *Westrope*, col. 7, ll. 28-36 (quoted above). None of the data sent to system 73 teaches or suggests a catalog and user information as recited in claim 1. No teaching, suggestion, or incentive exists to send the claimed information to system 73 because that information already exists and has been used as intended by the catalog services data processor 67. Thus, *Westrope* does not teach or suggest teach sending a catalog and user information to a plurality of secondary data processing systems, as recited in claim 1.

Regarding the latter system, *Westrope* only sends a signal to the marketing data processor 75 to generate the customer profile marketing data. *Westrope*, col. 7, ll. 36-44 (quoted above). None of the data sent to processor 75 teaches or suggests a catalog and user information as claimed. No teaching, suggestion, or incentive exists to send the claimed information to processor 75 because that information already exists and has been used as intended by catalog services data processor 67. Thus, neither of the systems to which the examiner refers is sent a catalog and user information in the manner claimed.

Furthermore, *Kennedy* does not teach or suggest anything that would cure the lack of disclosure in *Westrope* in this regard. The examiner does not assert otherwise. Hence, the cited

references do not teach or suggest all of the claimed features as asserted by the examiner and the proposed combination does not result in the invention of claim 1. Accordingly, under the standards of *In re Royka*, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 or any other claim in this grouping of claims.

A.1.ii. *Westrope* and *Kennedy* Combined Do Not Teach Sending a Catalog and User Information To a Plurality of Secondary Data Processing Systems

In addition, the proposed combination of *Westrope* and *Kennedy* when considered as a whole does not teach or suggest sending a catalog and user information to a *plurality of secondary data processing systems*, as recited in claim 1. The examiner asserts that *Westrope* teaches this claimed feature, asserting that processor 75 and/or processor 67 are secondary data processing systems. However, neither processor 75 nor processor 67 is a secondary data processing system, as claimed.

For example, marketing data processor 75 of *Westrope* is a single data processing system. The Office Action proffers no analysis as to why a single data processor is equivalent to a plurality of data processing systems. If the examiner means that processor 75 and processor 67 are a plurality of data processing systems to which inventory is allocated, the examiner is mistaken.

The examiner further alleges that *Westrope* teaches that catalog data processor 67 allocates inventory associated with the catalog to the plurality of data processing systems and references inventory memory 107 in Figure 8 for such a teaching. *Westrope* states that Figure 8 is a logic flow block diagram of the process and system apparatus for online interactive catalog system. Figure 8 of *Westrope* includes customer terminal 81 and other functional blocks shown and described with relation to Figure 4. However, the data files 107 in Figure 8 of *Westrope* in no way teach that catalog data processor 67 allocates inventory to a plurality of secondary data processing systems, as claimed. To the contrary, *Westrope* teaches a centralized store of inventory information. *Westrope* does not teach any allocation of inventory at all other than for fulfilling orders.

Still further, the examiner alleges that *Westrope* teaches receiving an order from one of the plurality of secondary data processing systems, which the examiner claims to establish as marketing data processor 75, and processing the order at col. 7, lines 23-30. The cited portion of *Westrope* states:

If a user elects to order a specific product or service, this is done under menu control at a user terminal and the menu would prompt the user to enter the appropriate order data codes via, for example, a touchtone telephone pad on the user terminal 63. In response to receipt of such user order data codes, the catalog data processing signals the accounting and order processor 73, which is similar in function and structure to the order and accounting processor of FIGS. 1 and 3 to exercise the appropriate order processing requests to clear the customer/user's financial payment authorization and initiate the order fulfillment procedure to have the ordered products assembled and mailed to the address directed by the user/customer for that particular transaction.

Westrope, col. 7, lines 23-36.

Thus, *Westrope* teaches that the catalog processing signals the order processor to exercise the appropriate order processing requests. *Westrope* does not teach that catalog services data processor 67, which the Office Action equated to the primary data processing system, receives an order from marketing data processor 75, which the Office Action equated to the plurality of secondary data processing systems.

The examiner appears to point to arbitrary elements in the reference as allegedly meeting the claimed feature of a plurality of secondary data processing systems.

Accordingly, the elements of *Westrope* are not combined and arranged as they are in the present claims. Additionally, *Kennedy* is devoid of disclosure in this regard, and the examiner does not assert otherwise. For this reason, the proposed combination of *Westrope* and *Kennedy* when considered together as a whole does not teach or suggest all of the features of claim 1. Therefore, under the standards of *In re Royka*, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 or against the other claims in this grouping of claims.

A.1.iii. *Westrope* and *Kennedy* Combined Do Not Teach “Allocating Inventory” as Asserted by the Examiner

The examiner states, and Applicants agree, that *Westrope* does not teach or suggest “allocating inventory,” as recited in claim 1. However, the examiner asserts that *Kennedy* teaches this claimed feature. Specifically, the examiner states that:

Westrope does not explicitly disclose allocating the inventory but *Kennedy* discloses for allocating products to sellers, for managing available to promise (ATP) and making promises to fulfill customer requests

Office Action of May 18, 2006, p. 2.

However, the examiner is manifestly incorrect. *Kennedy* does not teach allocating inventory, as recited in claim 1. Instead, *Kennedy* teaches allocating units of manufacturing capability that *Kennedy* refers to as “available to promise” units. For example, *Kennedy* teaches that:

To better meet customer demand, the manufacturer must build product and/or intermediate items before receiving customer orders. This production is based on projections called "forecast orders". A product produced based on these forecast orders is referred to as "available to promise" or "ATP". ***ATP consists of quantities of products with associated dates that the products are scheduled to be available for delivery to the customer.***

In distributed organizations a sales office may need approval from the factory before ATP may be promised to meet a customer request. This approval process may take up to a week under current practices. This delay is unacceptable in today's business environment.

Kennedy, col. 2, ll. 18-31 (emphasis added).

“Available to promise” units are units of manufacturing capability, not inventory, as recited in claim 1. The two features are not identical and the “available to promise” unit is not equivalent to inventory, as claimed. In fact, a simple “find” function in the text of *Kennedy* will show that the term “inventory” never appears anywhere in *Kennedy*. Thus, *Kennedy* does not suggest the claimed feature of “allocating inventory.” Accordingly, *Kennedy* does not teach or suggest the claimed feature of “allocating inventory,” as asserted by the examiner.

The examiner already admits that *Westrope* does not teach “allocating inventory,” as claimed, and impliedly admits that *Westrope* does not suggest this claimed feature. As shown above, *Kennedy* does not teach or suggest this claimed feature. Because neither *Westrope* nor *Kennedy* teaches or suggests this claimed feature, the proposed combination when considered as a whole does not teach or suggest this claimed feature. Therefore, under the standards of *In re Royka*, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 or any other claim in this grouping of claims.

A.I.iv. The Examiner Failed to State a Proper Teaching, Suggestion, or Motivation To Combine the References

In addition, the examiner failed to state a *prima facie* obviousness rejection against claim 1 because the examiner failed to state a proper teaching, suggestion, or motivation to combine the references. The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). In the case at hand the examiner has failed to establish a proper teaching, incentive, or suggestion supporting the combination and no such teaching, incentive, or suggestion exists. Nevertheless, the examiner states that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the allocation of products as taught by *Kennedy* into the data processing as taught by *Westrope* because it would provide an automatic allocation policy that allows the organization to designate a forecast entry such that the available-to-promise (ATP) product is always zero (col. 3, lines 18-21).

Office Action of May 18, 2006.

The examiner does not provide any teaching, suggestion, or motivation to combine the references with this statement. Instead, the examiner only copies the text from *Kennedy* regarding *Kennedy's* advantages in allocating manufacturing capability units that *Kennedy* refers to as “available to promise.” The examiner does not relate how *Kennedy's* advantages relate to *Westrope* or how one of ordinary skill would combine the references.

Additionally, *Kennedy's* cited features are not equivalent to the claimed “allocating inventory” step. The automatic allocation policy of *Kennedy* allows different representatives of the company to make fast promises to customers to manufacture items. This feature has nothing to do with the claimed feature of allocating inventory, or with any of the other features of claim 1. The examiner provides no basis for relating “available to promise” units to allocating inventory. The examiner provides no basis for *why* combining this manufacturing capacity unit with *Westrope* would result in the invention of claim 1 at all, much less why one of ordinary skill would find it

obvious to combine the references to result in the invention of claim 1.

Because the examiner provides no actual rationale or reasoning to combine the cited features of *Kennedy* with those of *Westrope*, the examiner has failed to state *any* teaching, suggestion, or motivation to combine the references. Thus, under the standards of *In re Napier*, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 or against any of the other claims in this grouping of claims.

A.1.v. No Motivation Exists to Combine *Westrope* and *Kennedy* Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 1 because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). In the case at hand, the cited references address distinct problems. Thus, no common sense reason exists to establish that one of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. Accordingly, no teaching, suggestion, or motivation exists to combine the references and the examiner has failed to state a *prima facie* obviousness rejection of claim 1.

For example, *Westrope* is directed to solving the problem of providing online catalogues to customers. For example, *Westrope* provides that:

A recent article in the July 1994 issue of Popular Science magazine reports several U.S. companies are taking tentative steps to replace or supplement printed catalog materials with an electronic or computerized catalog. For example, a number of U.S. companies are reported to be test marketing a CD-Rom disc which includes digital catalog data for a number of popular U.S. retailers' catalogs. Onscreen catalog displays are beginning to appear in retail stores as an electronic variation of the free-standing catalog kiosk or catalog department. Other retailers are experimenting with floppy disc versions of catalogs which would permit potential users to browse electronic catalog data on their PC computers.

The principal disadvantages of these earlier mail order or electronic catalog systems includes limitations on how, when and where the electronic catalog data can be viewed by a potential customer. Further, these earlier systems

generally require a separate or multi-step ordering process which are often cumbersome and time consuming. Further, interactive cable TV type systems often require each subscriber to use a dedicated channel for viewing video product information without the ability of the potential customer to select specific type products or services individually.

Westrope, col. 1, l. 49 through col. 2, l. 4.

On the other hand, *Kennedy* is directed to the problem of providing customers with quickly-provided promises to manufacture items by a particular date. For example, *Kennedy* provides as follows:

To better meet customer demand, the manufacturer must build product and/or intermediate items before receiving customer orders. This production is based on projections called "forecast orders". A product produced based on these forecast orders is referred to as "available to promise" or "ATP". ATP consists of quantities of products with associated dates that the products are scheduled to be available for delivery to the customer.

In distributed organizations a sales office may need approval from the factory before ATP may be promised to meet a customer request. This approval process may take up to a week under current practices. This delay is unacceptable in today's business environment.

Kennedy, col. 2, ll. 18-31.

Based on the plain disclosures of the references themselves, the references address completely distinct problems that are unrelated to each other. The problem of providing online catalogues to customers is completely distinct from the problem of providing customers with quickly-provided promises to manufacture items by a particular date.

Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the invention of claim 1. Thus, no proper teaching, suggestion, or motivation exists to combine the references in the manner suggested by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 or any other claim in this grouping of claims.

A.1.vi. The Age of the References Proves that No Motivation Exists to Combine the References

In addition, the age of the references proves that no motivation exists to combine the references. *Westrope* issued over seven years ago in October of 1999. *Kennedy* issued nearly six years ago in December of 2000. Thus, one of ordinary skill has had publicly available the combination of *Westrope* and *Kennedy* for over six years. The primary reference has been known for seven years.

However, in those intervening six and seven years no one of ordinary skill has combined the references to achieve the invention of claim 1, because no known publication or product teaches or suggests all of the features of claim 1. In further light of the value of the invention of claim 1, if had the invention of claim 1 been obvious, then one of ordinary skill would have already combined the references and either published a reference describing the claimed invention or produced a product incorporating the claimed invention.

However, the examiner has been unable to produce a single reference that teaches every feature of claim 1, and Applicants know of no such single reference. In the face of the failure of thousands of computer engineers and software programmers over the last seven years to disclose the invention of claim 1, the natural conclusion to draw is that claim 1 is non-obvious.

Because claim 1 is non-obvious, no teaching, suggestion, or motivation exists to combine the references to achieve the invention of claim 1. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 or any other claim in this grouping of claims.

A.2. Claims 4, 5, 35, and 36

Claim 4 is a representative claim in this grouping of claims. Claim 4 is as follows:

4. The method of claim 3, wherein the request to allocate the inventory is received from the particular secondary data processing system upon a detection of a condition by the secondary data processing system.

Regarding the rejection of claim 4, the examiner further states that:

As per claims 4, 5, 36 and 37, neither *Westrope* nor *Kennedy* discloses allocation of the inventory upon a detection of a condition which is a threshold but it is well known to set a condition when determining whether

or not an inventory is necessary because it would help determining the location of missing products, the examiner takes Official notice as such.

Office Action of May 18, 2006, p. 3.

Claim 4 depends on claim 1. Therefore, the examiner has failed to state a *prima facie* obviousness rejection against claim 4 at least by virtue of the fact that the examiner failed to state a *prima facie* obviousness rejection against claim 1, as described above.

Additionally, in rejecting claim 4, the examiner's statement purports to rely on "Official notice," which is allowed under the MPEP. However, the examiner's statement is only disallowed hand-waving in view of the lack of disclosure in the references in this regard and in further view of the examiner's manifest and obvious errors with regard to the teachings of the references. For example, the examiner believes that setting a condition when determining whether or not an inventory is necessary is "well known" simply because an advantage exists to setting such a condition. The examiner's logic is faulty because the existence of an advantage has nothing to do with whether a feature is "well known." In fact, inventors create new, patentable inventions in order to obtain advantages over the prior art on a regular basis. Thus, advantages, such as the one cited by the examiner, cannot be used as a reason to assert that a feature is "well known."

Given the admitted lack of disclosure in *Westrope* and *Kennedy* regarding the features of claim 4, and given that the combination of *Westrope* and *Kennedy* considered as a whole does not teach or suggest other features of claim 1, as shown above, the examiner is not entitled to take official notice regarding the feature not found in these references. If the examiner is relying on the examiner's own knowledge in this regard, then Applicants request that the examiner provide an affidavit under 37 C.F.R. §104(d)(2) or that the examiner withdraw the rejection and allow the claims.

Because the examiner is not entitled to take Official notice in the manner asserted and because the combination of *Westrope* and *Kennedy* does not teach or suggest all of the features of claim 4, the proposed combination of *Westrope*, *Kennedy*, and the Official notice does not teach or suggest all of the features of claim 4. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 4 and any other claim in this grouping of claims.

A.3. Claims 6, 7, 37, and 38

Claim 6 is a representative claim in this grouping of claims. Claim 6 is as follows:

6. The method of claim 1 further comprising:
periodically obtaining necessary shopping cart data from at least one secondary data processing system within the plurality of secondary data processing systems; and
forwarding the necessary shopping cart data to other secondary data processing systems within the plurality of secondary data processing systems.

Regarding the rejection of claim 6, the examiner further states that:

As per claims 6, 7, 38, and 39, *Westrope* discloses a system that is capable of providing a shopping cart data (items ordered by the user are stored in a safe place) from the secondary data processing system as claimed.

Office Action of May 18, 2006, p. 3.

Claim 6 depends on claim 1. Therefore, the examiner has failed to state a *prima facie* obviousness rejection against claim 6 at least by virtue of the fact that the examiner failed to state a *prima facie* obviousness rejection against claim 1, as described above.

Additionally, the proposed combination of *Westrope* and *Kennedy* does not teach or suggest the claimed feature of, “periodically obtaining *necessary* shopping cart data from at least one secondary data processing system within the plurality of secondary data processing systems,” as recited in claim 1. The examiner asserts otherwise, referring to “items ordered by the user are stored in a safe place.” However, the examiner’s assertion, even if correct, does not show how *Westrope* or *Kennedy* teach that the shopping cart data is *necessary*, as recited in claim 6.

In fact, neither *Westrope* nor *Kennedy* teach or suggest *necessary* shopping cart data. Therefore, the proposed combination of *Westrope* and *Kennedy* does not teach all of the features of claim 6. Accordingly, under the standards of *In re Royka*, the examiner has failed to state a *prima facie* obviousness rejection against claim 6 or any other claim in this grouping of claims.

B. GROUND OF REJECTION 2 (Claims 9, 10, 40, and 41)

B.1. Rejection of Claims 9 and 40

Claim 9 is a representative claim in this grouping of claims. Claim 10 is as follows:

9. The method of claim 8, wherein the markup language is extensible markup language.

Regarding the rejection of claim 9, the examiner states that:

As per claims 9, 10, 40 and 41, neither *Westrope* nor *Kennedy* discloses a catalog that is sent in a markup language and wherein the markup language is extensible markup language but *Yamazoe* discloses an application service on a network having a WWW (World Wide Web) voluntarily managed by the selling enterprise through the use of the XML (extensible markup language).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the allocation of products as taught by *Kennedy* into the data processing as taught by *Westrope* because it would provide an automatic allocation policy that allows the organization to designate a forecast entry such that the available-to-promise (ATP) product is always zero (col. 3, lines 18-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the extensible markup language (XML format) taught by *Yamazoe* et al into the combined system of *Westrope* and *Kennedy* because it would ensure a safe transmission of the information or document through a network.

Office Action of May 18, 2006, pp. 3-4.

Claim 9 depends from claim 1. The rejection of claim 1 is predicated upon the incorrect combination of *Westrope* and *Kennedy*. In addition, nothing in *Yamazoe* (2001/0032148) teaches or suggests the features missing from the combination of *Westrope* and *Kennedy* vis-à-vis claim 1, and the examiner does not assert otherwise. Therefore, the examiner has failed to state a *prima facie* obviousness rejection against claim 9, at least by virtue of the fact that claim 9 depends from claim 1.

Additionally, one of ordinary skill would not combine the references to achieve the invention of claim 9 because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). In the case at hand, the cited references address distinct problems. Thus, no common sense reason exists to establish that one of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. Accordingly, no teaching, suggestion, or motivation exists to combine the references and the examiner has failed to state a *prima facie* obviousness rejection of claim 9.

For example, *Westrope* is directed to solving the problem of providing online catalogues to customers. On the other hand, *Kennedy* is directed to the problem of providing customers with quickly-provided promises to manufacture items by a particular date. Based on the plain disclosures of the references themselves, the references address completely distinct problems that are unrelated to each other. The problem of providing online catalogues to customers is completely distinct from the problem of providing customers with quickly-provided promises to manufacture items by a particular date.

Furthermore, *Yamazoe* can be further distinguished from *Westrope* and *Kennedy*. *Yamazoe* is directed to the problem of low efficiency when conducting on-line negotiations. For example, *Yamazoe* provides that:

[0002] In a marketing operation for articles of commerce, represented by business sections of an enterprise, there arise an act of dealing (negotiation) for selecting an article of commerce and deciding the pricing; and an act of deciding an article of commerce to be purchased and placing an order in the process of a customer purchasing an article of commerce.

[0003] For a selling party, it is ideal to make sale efficiently at a reasonable price to as many channels as possible. To this end, attempts and artifices are extended to do an act of dealing for new and old customers to collect and analyze market needs to propose articles of commerce matched to the needs and reasonable prices in order to acquire a new order of articles of commerce from the customers.

Yamazoe, paragraphs 0002 and 0003.

The problem of low efficiency when conducting on-line negotiations, as addressed in *Yamazoe*, is wholly distinct from the problem of providing online catalogues to customers, as in *Westrope*, or the problem of providing customers with quickly-provided promises to manufacture items by a particular date, as in *Kennedy*. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the invention of claim 9. Thus, no proper teaching, suggestion, or motivation exists to combine the references in the manner suggested by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 9 or claim 40.

B.2. Rejection of Claims 10 and 41

Claim 10 is a representative claim in this grouping of claims. Claim 10 is as follows:

10. The method of claim 1 further comprising:
detecting a presence of another secondary data processing system;
and
sending the catalog to the another secondary data processing system
in response to detecting the presence.

Regarding the rejection of claim 10, the examiner states that:

As per claims 9, 10, 40 and 41, neither *Westrope* nor *Kennedy* discloses a catalog that is sent in a markup language and wherein the markup language is extensible markup language but *Yamazoe* discloses an application service on a network having a WWW (World Wide Web) voluntarily managed by the selling enterprise through the use of the XML (extensible markup language).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the allocation of products as taught by *Kennedy* into the data processing as taught by *Westrope* because it would provide an automatic allocation policy that allows the organization to designate a forecast entry such that the available-to-promise (ATP) product is always zero (col. 3, lines 18-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the extensible markup language (XML format) taught by *Yamazoe* et al into the combined system of *Westrope* and *Kennedy* because it would ensure a safe transmission of the information or document through a network.

Office Action of May 18, 2006, pp. 3-4.

Claim 10 depends from claim 1. The rejection of claim 1 is predicated upon the incorrect combination of *Westrope* and *Kennedy*. In addition, nothing in *Yamazoe* (2001/0032148) teaches or suggests the features missing from the combination of *Westrope* and *Kennedy* vis-à-vis claim 1, and the examiner does not assert otherwise. Therefore, the examiner has failed to state a *prima facie* obviousness rejection against claim 10, at least by virtue of the fact that claim 10 depends from claim 1.

Additionally, the proposed combination of *Westrope*, *Kennedy*, and *Yamazoe* when considered as a whole does not teach or suggest all of the features of claim 10. *Westrope* and *Kennedy* are as described above. *Yamazoe* is only cited for the existence of XML markup language, which is irrelevant to the features of claim 10. The proposed combination of *Westrope*,

Kennedy, and *Yamazoe* does not teach or suggest the claimed feature of, “detecting a presence of another secondary data processing system,” or the claimed feature of, “sending the catalog to the another secondary data processing system in response to detecting the presence.” The examiner does not assert otherwise. Therefore, the proposed combination when considered as a whole does not teach or suggest the features of claim 10. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 10 or claim 41.

Additionally, one of ordinary skill would not combine the references to achieve the invention of claim 10 because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). In the case at hand, the cited references address distinct problems. Thus, no common sense reason exists to establish that one of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. Accordingly, no teaching, suggestion, or motivation exists to combine the references and the examiner has failed to state a *prima facie* obviousness rejection of claim 10 or claim 41.

For example, *Westrope* is directed to solving the problem of providing online catalogues to customers. On the other hand, *Kennedy* is directed to the problem of providing customers with quickly-provided promises to manufacture items by a particular date. Based on the plain disclosures of the references themselves, the references address completely distinct problems that are unrelated to each other. The problem of providing online catalogues to customers is completely distinct from the problem of providing customers with quickly-provided promises to manufacture items by a particular date.

Furthermore, *Yamazoe* is directed to the problem of low efficiency when conducting on-line negotiations. The problem of low efficiency when conducting on-line negotiations, as addressed in *Yamazoe*, is wholly distinct from the problem of providing online catalogues to customers, as in *Westrope*, or the problem of providing customers with quickly-provided promises to manufacture items by a particular date, as in *Kennedy*. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the

references to achieve the invention of claim 10. Thus, no proper teaching, suggestion, or motivation exists to combine the references in the manner suggested by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 10 or claim 41.

C. CONCLUSION

As shown above, the examiner has failed to state a *prima facie* obviousness rejection against any of the claims. Therefore, Applicants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Applicants request that the Board direct the examiner to allow the claims.

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CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

1. A method in a primary data processing system for managing a catalog, the method comprising:

 sending a catalog and user information to a plurality of secondary data processing systems located in a network data processing system;

 allocating inventory associated with the catalog to the plurality of secondary data processing systems;

 receiving an order from one of the plurality of secondary data processing systems; and
 processing the order, in response to receiving the order.

2. The method of claim 1 further comprising:

 sending an update to the catalog to the plurality of secondary data processing systems.

3. The method of claim 1 further comprising:

 receiving a request to reallocate the inventory from a particular secondary data processing system within the plurality of secondary data processing systems;

 identifying a reallocation of the inventory in response to receiving the request; and

 sending messages to each secondary data processing system involved in the reallocation of the inventory.

4. The method of claim 3, wherein the request to allocate the inventory is received from the particular secondary data processing system upon a detection of a condition by the secondary data processing system.
5. The method of claim 4, wherein the condition is a threshold.
6. The method of claim 1 further comprising:
periodically obtaining necessary shopping cart data from at least one secondary data processing system within the plurality of secondary data processing systems; and
forwarding the necessary shopping cart data to other secondary data processing systems within the plurality of secondary data processing systems.
7. The method of claim 6, wherein a secondary data processing system within the plurality of secondary data processing systems periodically obtains necessary shopping cart data from a particular secondary data processing system within a plurality of secondary data processing systems; and forwards the necessary shopping cart data to other secondary data processing systems within the plurality of secondary data processing systems.
8. The method of claim 1, wherein the catalog is sent in a markup language document.
9. The method of claim 8, wherein the markup language is extensible markup language.

10. The method of claim 1 further comprising:
detecting a presence of another secondary data processing system; and
sending the catalog to the another secondary data processing system in response to
detecting the presence.
11. The method of claim 1, wherein the plurality of secondary data processing systems are
located within a network data processing system.
12. The method of claim 11, wherein the network data processing system is at least one of a
wide area network, an intranet, and the Internet.
13. The method of claim 1, wherein the catalog is a first catalog, the inventory is a first
inventory, and further comprising:
sending a second catalog to a second plurality of secondary data processing systems; and
allocating the second inventory to be associated with the second catalog to the second
plurality of secondary data processing systems.
14. The method of claim 13, wherein a particular item is present in the first catalog and the
second catalog.
15. The method of claim 13, wherein a selected secondary server is part of the first plurality
of secondary servers and the second plurality of secondary servers.

32. A data processing system for managing a catalog, the data processing system comprising:
sending means for sending a catalog and user information to a plurality of secondary data processing systems located in a network data processing system;

allocating means for allocating inventory associated with the catalog to the plurality of secondary data processing systems;

receiving means for receiving an order from one of the plurality of secondary data processing systems; and

processing means for processing the order, in response to receiving the order.

33. The data processing system of claim 32, wherein the sending means is a first sending means and further comprising:

second sending means for sending an update to the catalog to the plurality of secondary data processing systems.

34. The data processing system of claim 32, wherein the receiving means is a first receiving means, the sending means is a first sending means and further comprising:

second receiving means for receiving a request to reallocate the inventory from a particular secondary data processing system within the plurality of secondary data processing systems;

identifying means for identifying a reallocation of the inventory in response to receiving the request; and

third sending means for sending messages to each secondary data processing system involved in the reallocation of the inventory.

35. The data processing system of claim 34, wherein the request to allocate the inventory is received from the particular secondary data processing system upon a detection of a condition by the secondary data processing system.

36. The data processing system of claim 35, wherein the condition is a threshold.

37. The data processing system of claim 32 further comprising:

obtaining means for periodically obtaining necessary shopping cart data from at least one secondary data processing system within the plurality of secondary data processing systems to primary data processing system; and

forwarding means for forwarding the necessary shopping cart data to other secondary data processing systems within the plurality of secondary data processing systems.

38. The data processing system of claim 37, wherein a secondary data processing system within the plurality of secondary data processing systems periodically obtains necessary shopping cart data from a particular secondary data processing system within a plurality of secondary data processing systems; and forwards the necessary shopping cart data to other secondary data processing systems within the plurality of secondary data processing systems.

39. The data processing system of claim 32, wherein the catalog is sent in a markup language document.

40. The data processing system of claim 39, wherein the markup language is extensible markup language.

41. The data processing system of claim 32, wherein the sending means is a first sending means and further comprising:

detecting means for detecting a presence of another secondary data processing system;

and

fourth sending means for sending the catalog to the another secondary data processing system in response to detecting the presence.

42. The data processing system of claim 32, wherein the plurality of secondary data processing systems are located within a network data processing system.

43. The data processing system of claim 42, wherein the network data processing system is at least one of a wide area network, an intranet, and an Internet.

44. The data processing system of claim 32, wherein the catalog is a first catalog, the inventory is a first inventory, the sending means is a first sending means, the allocating means is a first allocating means and further comprising:

fifth sending means for sending a second catalog to a second plurality of secondary data processing systems; and

second allocating means for allocating the second inventory to associated with the second catalog to the second plurality of secondary data processing systems.

45. The data processing system of claim 44, wherein a particular item is present in the first catalog and the second catalog.

46. The data processing system of claim 44, wherein a selected secondary server is part of the first plurality of secondary servers and the second plurality of secondary servers.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.